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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/265,119      | 03/09/1999  | MAURIZIO PERI        | 856063.579          | 4151             |

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[REDACTED] EXAMINER

SHARON, AYAL I

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2123     |              |

DATE MAILED: 01/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**REQUIREMENT FOR INFORMATION – 37 C.F.R. § 1.105**

1. As stated in the first Office Action (paper #7), Examiner located an article titled "Onwards and Upwards: New developments in 8-bit Micros" (Found in Challenge: News and Views from STMicroelectronics, March 1999. Listed as Item 'V' in the PTO-892 form, 'Notice of References Cited', provided with paper #7). This article, published by the Assignee and was found on the Assignee's Internet web site, states that:

"Although it is possible to make part of the Flash memory look like EEPROM by means of software simulation, this approach does not ideal [sic] in embedded applications. For the ST9 and ST10 families, ST offers a unique, patented solution to this problem. The process used is also able to provide hardware emulation of EEPROM functionality ...(p.2)"

2. **Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application:**
  - A list of the foreign and domestic patent numbers of the "patented solution" referred to in the article "Onwards and Upwards: New developments in 8-bit Micros".
  - Assignee's datasheets and user's manuals, dating back to 1992, for the ST9 Microcontroller family referred to in the article "Onwards and Upwards: New developments in 8-bit Micros".

This information is required to identify products and services embodying the disclosed subject matter of EEPROM emulation using Flash memory, and to identify the properties of similar products and services found in that prior art.

3. The Applicants' state that "the references requested are not materially related to the subject matter of Applicant's application, and hence are not material to patentability (see paper #9, p.13)." Examiner requires copies of the references.
4. The required references are "materially related to the subject matter of Applicant's application", and hence are "material to patentability".

For example, the "Onwards and Upwards: New developments in 8-bit Micros" article teaches that:

"Although it is possible to make part of the Flash memory look like EEPROM by means of software simulation, this approach does not ideal [sic] in embedded applications. For the ST9 and ST10 families, ST offers a unique, patented solution to this problem. The process used is also able to provide hardware emulation of EEPROM functionality ..."

Examiner notes that (1) the ST9 and ST10 are manufactured by the Assignee, and (2) the article was published in a publication named after the Assignee, and (3) the cited article was found on the Assignee's internet web site.

The cited paragraph indicates the relevance of the ST9 and ST10 disclosures. Moreover, the reference to a "patented solution" implies that there may exist unnamed patents held by the manufacturer of the ST9 and ST10 (i.e. the Assignee) that claim the above specified functionalities.

5. The ST9 Microcontroller cited in the "Onwards and Upwards" article has apparently been manufactured and sold by the Assignee all the <sup>way</sup> back to 1992.

The Andretta et al. article cited in the IDS of the first Office Action, "Testing of the ST9 Microcontroller", dated Sept. 5-8, 1994, provides evidence that information about the ST9 Microcontroller was available in the public domain back to 1994.

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Moreover, the document titled "Documents and files for family ST9", which was found on the Assignee's internet web site and is being provided with this office action, makes reference to a file "AN-413, Initialization of the ST9", dated Dec, 1992. Thus there is evidence that the ST9 was manufactured and sold back to 1992.

Thus, an issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: ST9 datasheets and user's manuals.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

This issue can be resolved by an Examiner's examination of the ST9 datasheets and user's manuals

There are ST9 datasheets and user's manuals listed in the document "Documents and files for family ST9". (e.g. Items ST90158, ST90135, ST92141, ST92163, etc.). However, they are all dated 2001 or 2002. Thus, only datasheets and user's manuals (and other relevant design or specification documents of the ST9) needed are those published more than a year prior to the application's foreign priority filing date.

6. **The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement.** This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105

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that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

- 7. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56.** Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.
- 8. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ayal I. Sharon whose telephone number is (703) 306-0297. The examiner can normally be reached on Monday through Thursday, and the first Friday of a biweek, 8:30 am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on (703) 305-9704. Any response to this office action should be mailed to:

Director of Patents and Trademarks  
Washington, DC 20231

Hand-delivered responses should be brought to the following office:

4<sup>th</sup> floor receptionist's office  
Crystal Park 2  
2121 Crystal Drive  
Arlington, VA

The fax phone numbers for the organization where this application or proceeding is assigned are:

|                                     |                |
|-------------------------------------|----------------|
| Official communications:            | (703) 746-7239 |
| Non-Official / Draft communications | (703) 746-7240 |
| After Final communications          | (703) 746-7238 |

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is:  
(703) 305-3900.

Ayal I. Sharon

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January 17, 2003



KEVIN J. TESKA  
SUPERVISORY  
PATENT EXAMINER